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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)	
	10/733,102	ELKADY ET AL.	
Office Action Summary	Examiner	Art Unit	
	Neil R. McLean	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>8/26/2008</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-29</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-29</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1.　　Claims 1-29 are now pending in this application.

　　Claim 29 is new.

Response to Arguments

2.　　Applicant's arguments, with respect to the rejection(s) of claim(s) 1-28 are

persuasive, therefore, the rejection has been withdrawn. However, upon further

consideration, a new ground(s) of rejection is made in view of Schwier et al. (US

7,202,972) hereinafter 'Schwier'.

Claim Rejections - 35 USC § 102

3.　　The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.　　Claims 1-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Schwier

et al. (US 7,202,972) hereinafter 'Schwier'.

Regarding Claim 1: (previously presented)

Schwier et al. discloses a method comprising:

receiving (In order to merge the system must receive a merge command from the browser or program code), at a merge utility (e.g., Winword Application 10 in Figure 2) executing on a computer system (e.g., Personal Computer 1 in Figure 1), a first merge document (e.g., Static Data 12 created by WinWord Application 10 in Figure 2) that is in a merge format;

converting a second document (e.g., Excel document) from an original format to the merge format to create a second merge document (e.g., PCL described in Column 1, lines 16-20);

wherein the second document was created by a first document authoring application (e.g., WinWord Program 10 in Figure 2);

wherein the second merge document is in the merge format (e.g., PCL described in Column 1, lines 16-20);

wherein the step of converting is performed by either the merge utility or the first document authoring application (e.g., Column 5, lines 23-43);

using the merge utility executing on the computer system, merging the first merge document (e.g., Variable Data V) and the second merge document (e.g., Static Data S) to generate a composite merge document (e.g., V+S (EMF) 13 in Figure 2); and

after generating the composite merge document delivering said composite merge document to an output device (FIG. 3 shows a selection window that is selected before the printing event from the application ensues into the EMF intermediate datafile (event 13). The input window 20 contains a first selection window 21 in which two print modes can be selected. In the first print mode (standard), print data from the windows application are printed out in a standard way, i.e. the filter procedure (event 14) does not occur. Series letters are then transmitted to the printer device 7 individual document by individual document.);

wherein the output device is a device that is different from the computer system (e.g., printer device 7 of Figure 1 and 2);

wherein the original format is a format that is not supported by the output device (e.g., EMF Format); and

therefore needs to be converted to another format that is supported by the output device in order to be properly interpreted by the output device (e.g., using PCL Converter 18 of Figure 2); and

wherein the merge format is a format that is supported by the output device (e.g., PCL); and

therefore does not need to be converted to another format that is supported by the output device in order to be properly interpreted by the output device (e.g, EMF to PCL converter 58 of Figure 9).

Regarding Claim 15:   (previously presented)

Claim 1 teaches the method. Claim 15 is obvious in view of Schwier because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 1.

Regarding Claim 2: (original)

Schwier et al. further discloses the method of claim 1 further comprising: generating the first merge document in said merge format by converting a first original document from an original format to the merge format (See PCL converter 58 in Figure

9).

Regarding Claim 16:   (previously presented)

Claim 2 teaches the method. Claim 16 is obvious in view of Schwier because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 2.

Regarding Claim 3: (original)

Schwier et al. further discloses the method of claim 1, wherein the merge format is Standard Printing and Imaging Format (SPIF) (Column 3, lines 61-64; 'the conversion of the data stream into a print language such as PCL or postscript').

Regarding Claim 17:   (previously presented)

Claim 3 teaches the method. Claim 17 is obvious in view of Schwier because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 3.

Regarding Claim 4: (original)

Schwier et al. further discloses the method of claim 3, wherein the merge format is PDL Postscript (Column 3, lines 61-64; 'the conversion of the data stream into a print language such as PCL or **postscript**').

Regarding Claim 18:   (previously presented)

Claim 4 teaches the method. Claim 18 is obvious in view of Schwier because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 4.

Regarding Claim 5: (original)

Schwier et al. further discloses the method of claim 1, wherein the first document is a background template document and the second document is an overlay document (Column 8, lines 64-67; 'The placement type as an **overlay** (complete superimposition) **or** a **watermark** (macro information only in the background) within the document **can be selected** with the selection field 44').

Regarding Claim 19:   (previously presented)

Claim 5 teaches the method. Claim 19 is obvious in view of Schwier because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 5.

Regarding Claim 6: (previously presented)

Schwier et al. further discloses the method of claim 5, wherein the background template document is originally created by a second document authoring **application** (Column 5, lines 23-30; 'Various application programs in turn run under this operating system, for example the **application** 10 Winword 97.RTM. from the Microsoft Office 97.RTM. package'); and

wherein the second document authoring application is different (Column 5, lines 35-38; 'The variable data areas are intended to be filled with variable data that are stored in a separate datafile (a Word document, data bank, an Excel document, etc.') from said first document authoring application.

Regarding Claim 20:   (previously presented)

Claim 6 teaches the method. Claim 20 is obvious in view of Schwier because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 6.

Regarding Claim 7: (original)

The method of claim 5, wherein the background template document is created in a second original format (Column 5, lines 35-38; 'The variable data areas are intended to be filled with variable data that are stored in a separate datafile (a Word document, data bank, an Excel document, etc.') and converted from the second original format to the merge format (See PCL converter 58 in Figure 9).

Regarding Claim 21:   (previously presented)

Claim 7 teaches the method. Claim 21 is obvious in view of Schwier because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 7.

Regarding Claim 8: (previously presented)

Schwier et al. further discloses the method of claim 7, wherein the conversion of the second original document to the merge format occurs at the merge utility (FIG. 3 shows a selection window that is selected <u>before the printing event</u> from the application ensues into the EMF intermediate datafile (event 13). The input window 20 contains a first selection window 21 <u>in which two print modes can be selected</u>. In the first print mode (standard), print data from the windows application are printed out in a standard way, i.e. **the filter procedure (event 14) does not occur**. Series letters are then transmitted to the printer device 7 individual document by individual document.).

Regarding Claim 22:   (previously presented)

Claim 8 teaches the method. Claim 22 is obvious in view of Schwier because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 8.

Regarding Claim 9: (previously presented)

Schwier et al. further discloses the method of claim 1, wherein the converting of the second document from the original format to the merge format to create the second merge document includes:

generating, based on the original format, a set of conversion instructions (The program code or device which enables the PCL converter 18 in Figure 2) to convert the second document into said second merge document;

passing the set of conversion instructions to a document authoring application
(Column 4, lines 15-20); and

the first document authoring application generating the second merge document
based on said set of conversion instructions (Column 4, lines 15-20).

Regarding Claim 23:   (previously presented)

Claim 9 teaches the method. Claim 23 is obvious in view of Schwier because a
computer-readable medium containing computer executed instructions is achieved
using the method steps of Claim 9.

Regarding Claim 10:   (previously presented)

Schwier et al. further discloses the method of claim 1, wherein the method
further comprises receiving a request to merge documents containing information about
a document authoring application (Column 4, lines 25-26; 'the referencing is thereby
particularly controlled via data that are input via a user interface') that created the second
document; and

wherein the converting of the second document from the original format to the
merge format to create the second merge document includes:

generating, based on the information about the document authoring application,
a set of conversion instructions (The program code or device which enables the PCL
converter 18 in Figure 2) to convert the second document into said second merge
document;

passing the set of conversion instructions to the document authoring application

(Column 9, lines 59-62; "Enhanced Print Environment (EPE) Print Processor" 49a does not forward

the EMF data directly to the port monitor 51 but calls the converter unit 58, wherein the EMF data stream

is converted into a PCL print data stream 60'); and

the document authoring application generating the second merge document

based on said set of conversion instructions (Column 9, lines 65-67, 'The conversion is

thereby controlled by the parameters that were previously input via the input module 59').

Regarding Claim 24:   (previously presented)

Claim 10 teaches the method. Claim 24 is obvious in view of Schwier because a

computer-readable medium containing computer executed instructions is achieved

using the method steps of Claim 10.

Regarding Claim 11:   (original)

Schwier et al. further discloses the method of claim 1, wherein the composite

merge document is in the merge format (Column 3, lines 56-67).

Regarding Claim 25:   (previously presented)

Claim 11 teaches the method. Claim 25 is obvious in view of Schwier because a

computer-readable medium containing computer executed instructions is achieved

using the method steps of Claim 11.

Regarding Claim 12:   (original)

    Schwier et al. further discloses the method of claim 1, wherein the composite

merge document is a **template** for creating other documents (FIG. 5 shows a **master**

document 25).

Regarding Claim 26:   (previously presented)

    Claim 12 teaches the method. Claim 26 is obvious in view of Schwier because a

computer-readable medium containing computer executed instructions is achieved

using the method steps of Claim 12.

Regarding Claim 13:   (previously presented)

    Schwier et al. further discloses the method of claim 1, further comprising;

    Receiving at the merge utility, a request to merge wherein the steps of converting

the second document and merging the first merge document and the second merge

document are both performed in response to the merge utility receiving the request to

merge documents. documents (The program code which is embodied on a computer

readable media and operable to requests the merge utility described in Column 6, lines

8-18 to merge documents and in Claim 20.)

Regarding Claim 27:   (previously presented)

Claim 13 teaches the method. Claim 27 is obvious in view of Schwier because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 13.

Regarding Claim 14:   (previously presented)

Schwier et al. further discloses the method of claim 1 further comprising:

receiving at the merge utility, a request to merge documents (Column 7, lines 20-25; in order to merge the system must receive a merge command);

generating the first merge document in said merge format by converting a first original document from an original format to the merge format (See PCL converter 18 in Figure 2);

wherein the merge format is Standard Printing and Imaging Format (SPIF) (Column 3, lines 61-64; 'the conversion of the data stream into a print language such as PCL or postscript');

wherein the first document is a background template document and the second document is an overlay document (Column 8, lines 64-67; 'The placement type as an **overlay** (complete superimposition) **or a watermark** (macro information only in the background) within the document **can be selected** with the selection field 44').

wherein the background template document is originally created by a first document authoring application; and

wherein the second document authoring application that is different from said first document authoring application;

wherein the background template document is created in a second original

format and converted from the second original format to the merge format.

Regarding Claim 28:   (previously presented)

Claim 14 teaches the method. Claim 28 is obvious in view of Schwier because a

computer-readable medium containing computer executed instructions is achieved

using the method steps of Claim 14.

Regarding Claim 29: (New)

Schwier discloses the method of Claim 1, wherein the first merge document is a

version of a first document that has been converted from an original format to the merge

format (e.g., Word application converted to PCL as shown in Figure 9).

Conclusion

5.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Sciatto (US 6,330,073) discloses A system and method for

generating a plurality of customized documents having at least one portion of common

information and at least one portion of variable information.

Examiner Notes

6.   The Examiner cites particular columns and line numbers in the references as

applied to the claims above for the convenience of the applicant. Although the specified

citations are representative of the teachings in the art and are applied to the specific

limitations within the individual claim, other passages and figures may apply as well. It

is respectfully requested that, in preparing responses, the applicant fully considers the

references in its entirety as potentially teaching all or part of the claimed invention, as

well as the context of the passage as taught by the prior art or as disclosed by the

Examiner.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Neil R. McLean whose telephone number is (571)270-

1679. The examiner can normally be reached on Monday through Friday   7:30AM-

4:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David K. Moore can be reached on 571.272.7437. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Neil R. McLean/
Examiner, Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625